

Remarks/Arguments

Reconsideration and allowance of the above application, in view of the following remarks, are respectfully requested. Claims 1-47 are pending in the application. Claim 1-4, 7-15, 18-21, 23-35, 37, 38 and 40-47 stand rejected. Claims 16, 17, 22 and 39 are under objection.

Rejections Under 35 U.S.C. § 112

Claim 36 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant respectfully traverses this rejection and requests withdrawal thereof for at least the reasons set forth below.

Claim 36 requires the fluid of claim 1 to be free of any other friction modifier other than succinimide. The Examiner has rejected claim 36 as indefinite because the claimed antiwear component from claim 1 is deemed by the Examiner to also be a friction modifier and therefore the limitation would require the elimination of a required element from independent claim 1.

Applicant respectfully submits that claim 36 is not indefinite. Claim 36 is definite because the Applicant has expressly required the presence of an antiwear component in claim 1. The further limitation expressed in claim 36 does not remove the antiwear component from the claimed power transmission fluid in claim 36. It is axiomatic that a dependent claim must contain all the elements of the base or independent claim. See 35 U.S.C. § 112, fourth paragraph. Therefore, all the elements of claim 1 must necessarily be present in dependent claim 36. The added limitation provided in claim 36 will only serve to restrict the presence of non-metallic friction modifiers other than succinimide. Applicant, having the right to be his own

lexicographer, has generally described organic esters of phosphoric acid, phosphorus acid, or an amine salt thereof as phosphorus-containing antiwear components. The fact that the antiwear component may possess additional properties, such as, e.g., friction modification, does not render the antiwear component a friction modifier within the bounds of the negative limitation expressed in claim 36.¹ There is nothing ambiguous or indefinite with regard to claim 36.

Rejections Under 25 U.S.C. § 102

Claims 1-4, 7-15, 18-21, 23-35, 37, 38 and 40-47 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Norman (U.S. Patent No. 5,942,470). Applicant respectfully traverses this rejection and requests withdrawal thereof for at least the reasons set forth below.

Norman generally discloses gear oil, i.e., gear or manual transmission compositions, having a base oil, a succinimide, a sulfur-containing extreme pressure or antiwear agent, and an amine salt of a partial ester of an acid of phosphorus. The succinimide is preferably an alkenyl succinimide and may be post-treated with a boron post-treating agent to introduce boron into the succinimide dispersant. See Norman at col. 15, line 50. However, there is no single gear oil embodiment within Norman that discloses a borated succinimide dispersant having boron at 1 wt.% or below. The examples disclosed within Norman that include borated dispersants, Examples 9, 13 and 30-32, all require 1.3 wt.% boron, an amount clearly outside the claimed range of the present invention. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

¹ The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. See MPEP 2173.05(i)

Because Norman neither expressly nor inherently discloses an automatic transmission fluid having all the elements of the presently claimed invention, Norman cannot anticipate the present claims.

Applicant submits that the claimed invention is not anticipated or rendered obvious by any of the cited references alone or in combination. Applicants respectfully submit that the present invention is in condition for allowance and allowance is respectfully requested. If the Examiner has any questions regarding this submission or if an interview at this time would further the progress of this application to a favorable conclusion, please contact the undersigned at the telephone number provided.

The applicant believes that no additional fees are due. If there are any additional fees due in connection with the filing of this response the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 051372.

Respectfully submitted,

By: _____

J. Clay Matthews, Ph.D.
Attorney for Applicant
Registration No. 50,735
Telephone: (804) 788-5517
Facsimile: (804) 788-5519

Dated: June 13, 2006